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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,471	07/20/2001	Jeffrey K. Wilkins	WIL-102	1749
30869	7590	05/20/2005	EXAMINER	
LUMEN INTELLECTUAL PROPERTY SERVICES, INC. 2345 YALE STREET, 2ND FLOOR PALO ALTO, CA 94306			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/910,471

Applicant(s)

WILKINS ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Amendment received on 8/27/2004 is acknowledged and entered. **Claims 16-17 and 33-84** have been previously canceled. **Claim 1** has been amended. **Claims 1-15 and 18-32** are currently pending in the application.

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections under 35 USC § 101 have been withdrawn based on the applicant's arguments.

Upon reconsideration, Claim Objections in respect to Claims 1-15, 18-29 and 31 has been withdrawn.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 5-11, 13-14, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. (US 6,338,067) in view of Wical (US 6,061,675).**

Baker et al. (hereinafter Baker) teaches a method and system for searching a structured database containing information (*files*) related to various entities, comprising:

As per **claims 1, 29 and 31**, searching said database over the Internet to identify and obtain information related to a company management record, management title record, management background, contact names, including addresses, telephone and

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fax numbers, web site and email addresses (Fig. 2; C. 3, L. 25-28; C. 6, Table II; C. 7, L. 25-41). Various types of information are relationally linked across the Internet, and accessible to a user over the net by querying key terms (individual data items) (C. 2, L. 3-16).

However, Baker does not specifically teach that said querying key terms includes parsing technique; determining a context; evaluating a past tense relationship of the extracted title and name records; and selecting said records based on said evaluating step.

Wical teaches a method and system for classifying terminology utilizing a structured database, wherein a parsing technique is employed to determine a verb tense, wherein said verb is selected based on said determination (C. 78, L. 14-15; C. 52, L. 11-19, C. 70, L. 19-22).

It would have been obvious to one having ordinary skill in the art to modify Baker to include parsing the quires for key terms, and evaluating a past tense relationship of the extracted information, as disclosed in Wical, because it would advantageously permit a detailed and in-depth coverage of specific concepts contained in a particular data structure, as well as the best mode of utilization information, as specifically stated in Wical (C. 2, L. 19-21).

Information as to *senior* management is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Baker in view of Wical, would be performed the same regardless whether said management record relates to senior management, or not.

As per **claims 5-10**, obtaining said information over the Internet indicates accessing websites (Baker; C. 3, L. 25-26). Information as to "*corporate*", "*magazine*",

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"newspaper", "press release", "professional" and/or "association" web sites is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Baker and Wical would be performed the same regardless of the type or content of web sites.

As per **claim 11**, obtaining said information over the Internet obviously indicates using a publicly accessible search engine (Baker; C. 3, L. 25-26).

As per **claims 13-14**, see reasoning applied to claim 1.

**Claims 2-4, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Wical and further in view of Johnson et al. (US 6,553,385).**

As per **claims 2-4**, Baker and Wical teach all the limitations of claims 2-4, including storing web site addresses of accessed files (C. 6, Table II), except evaluating a confidence level of the results of the search.

Johnson et al. (herein after Johnson) teaches a method and system for information extraction from documents, wherein a confidence measurement is applied to the search results (C. 10, L. 20-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include evaluating a confidence level of the results of the search, because it would allow to determine which searching technique is the most accurate, thereby enhance the performance of the system.

As per **claims 30 and 32**, Baker and Wical teach: a searching means for obtaining structured database information over the Internet; said information is related

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to a company management record, management title record, management background, contact names, including addresses, telephone and fax numbers, web site and email addresses (Baker; Fig. 2; C. 3, L. 25-28; C. 6, Table II; C. 7, L. 25-41); a parsing means and tense evaluation means for determining a past tense relationship of the extracted title and name records (Wical; C. 78, L. 14-15).

However, Baker and Wical do not teach integrity evaluation means for determining whether said obtained information is valid.

Johnson teaches a method and system for information extraction from documents, including means for confidence (*integrity*) measurement of the search results (C. 10, L. 20-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include means for evaluation of the integrity level of the obtained information, as disclosed in Wical, because it would advantageously allow to determine which searching technique is the most accurate, thereby enhance the performance of the system.

**Claim 12 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker and Wical in view of Lawrence et al. (US 6,289,342).**

As per **claim 12**, Baker and Wical teach all the limitations of claim 12, including obtaining said information over the Internet (Baker; C. 3, L. 25-26), except using a custom designed spider.

Lawrence et al. (hereinafter Lawrence) teaches autonomous citation indexing and literature browsing using citation context, wherein a "crawler" (*spider*) module is employed (C. 29, L. 29-35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include that said information was obtained using a spider, as disclosed in Lawrence, because without indicating the advantage of using a spider over the prior art, using said spider is appears to be a matter of business choice.

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Information as to "*custom designed*" spider is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Also, Lawrence teaches:

As per **claims 18-19**, using identifiers to locate said data (C. 8, L. 65 – C. 9, L. 28).

As per **claims 20-21**, rating said business data (C. 11, L. 8-9).

As per **claim 22**, using inclusion and exclusion characteristics to extract said business data (C. 12, L. 7-11).

As per **claim 23**, normalizing said business data (C. 12, L. 7-23; C. 14, L. 29-67).

As per **claim 24**, eliminating duplicate sets of business data (column 8, lines 8-9).

**Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker and Wical in view of Maddalozzo, Jr. et al. (US 6,460,060).**

As per **claim 15**, Baker and Wical teach all the limitations of claim 15, except that said files are located using a previously generated list of said files.

Maddalozzo, Jr. et al. (hereinafter Maddalozzo) teaches a method and system for searching web browser history, wherein searching for files over the Internet is based on the previously generated list of said files (C. 2, L. 37-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include that searching for files over the Internet is based on the previously generated list of said files, as disclosed in Maddalozzo, because it would advantageously allow to save time during browsing the "favorite" sites, thereby make the browsing convenient to users.

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**Claims 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker and Wical in view of Yong (US 6,560,606).**

As per **claims 25-26 and 28**, Baker and Wical teach all the limitations of claims 25-26 and 28, except extracting date or time stamps of said files containing said information.

Yong teaches a method and system for processing of metered data, including extracting time stamps of the located files (C. 7, L. 48-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include extracting time stamps of the located files, as disclosed in Yong, because it would advantageously allow to differentiate fees for using said system in accordance with peak hours, thereby providing billing flexibility to the users.

**Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, Wical and Maddalozzo in view of Yong (US 6,560,606).**

As per **claim 27**, Baker, Wical and Maddalozzo teach all the limitations of claim 27, including searching for files based on the previously generated list of said files (Maddalozzo; C. 2, L. 37-45), except extracting date or time stamps of said files containing said information.

Yong teaches a method and system for processing of metered data, including extracting time stamps of the located files (C. 7, L. 48-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker, Wical and Maddalozzo to include extracting time stamps of the located files, as disclosed in Yong, because it would advantageously allow to differentiate fees for using said system in accordance with peak hours, thereby providing billing flexibility to the users.



### ***Response to Arguments***

Applicant's arguments filed 8/27/04 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art does not teach *determining a context of a string of a text*, the examiner points out that Wical was applied for this feature. Specifically, Wical teaches said method and system for classifying terminology utilizing a structured database, wherein "the linguistic engine extracts the topic and content for each sentence in the input discourse" (C. 52, L. 11-14). Furthermore, Wical teaches: "the thematic assessments are a series of tests made against each word/phrase in the exact context of the sentence" (C. 70, L. 14-16).

In response to applicant's argument that the prior art does not teach *information retrieval from a huge disorganized data repository such as the Internet containing all types of files*, it is noted that Baker was applied for this feature. Specifically, Baker teaches searching databases over the Internet to identify and obtain needed information, said information being related to various companies in various industries (C. 2, L. 9-10; C. 3, L. 25-28).

In response to applicant's argument that the prior art does not teach *searching the Internet to identify and obtain files containing senior management information*, it is noted that Baker was applied for this feature. Specifically, Baker teaches searching databases over the Internet to identify and obtain information related to a company management record, management title record, management background, contact names, including addresses, telephone and fax numbers, web site and email addresses (Fig. 2; C. 3, L. 25-28; C. 6, Table II; C. 7, L. 25-41).

In response to applicant's argument that the prior art does not teach *information retrieval from a file that could possibly change structure and content in time and place*, it is noted that the said features is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that *Wical's teaching of "IsWhatTense" is not deterministic to any words or any selection of the words*, the examiner stipulates that Wical explicitly discloses valuing a word based on its past tense. Specifically, Wical teaches: "Returns the verb tense for the word being pointed to. Only 'past' and 'present' are valid" (C. 78, L.13-14).

In response to applicant's argument that the prior art teaches a *structured* database, which is not what the claimed invention teaches for, the examiner stipulates:

Firstly, there is no indication in the independent claim 1 of what type of database is searched. The sub-step a) in claim 1 recites: *searching the Internet to identify and obtain files containing certain information*.

Secondly, dependent claim 14 recites: *wherein said files contain structured information*.

Furthermore, in any case, it appears that information as to *structural or not structural database* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Baker in view of Wical would be performed the same regardless whether said database is structured or not.

***Conclusion***

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (571) 272-6812.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 872-9306**

[Official communications; including After Final  
communications labeled "Box AF"]

IB

11/19/2004

  
**JOHN G. WEISS  
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